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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,901	06/24/2003	Ken R. Powell	104.028-03	7578

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Law Office of Jerome D. Jackson  
Suite 100  
211 N. Union Street  
Alexandria, VA 22314

EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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06/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,901	<b>Applicant(s)</b> POWELL ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-10,12,15-19 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-10,12,15-19 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

**1. Claims 2,4-10,12,15-19 and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

- Claim 16 depends from canceled claim 11, thereby rendering the claim scope uncertain.
- Claim 23, it is unclear whether this claim is a method or system claim. The preamble attempts to set forth large amounts of structure which confuses the claim scope of this apparent method claim. The claim presently is taken to merely require the steps of detecting and displaying. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim “is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved” and is “ambiguous.” MPEP 2173.05(p)(ii).
- Claim 23's method step of displaying an amount is clear; however the language that suggests the amount varies renders the method claim's scope unclear. The variability mentioned is likened to method steps that *might have been performed under a different signal condition*, yet steps that might have been performed cannot limit a method claim which is supposed to define only

- steps that are performed. If applicant desires variability, perhaps he should claim a second set of steps (detecting...displaying) for a different scenario.
- Claims 25, 27, it is unclear if applicant is claiming a system or a store or both. The use of the two appearances of “(store) comprising” and “(system) comprising” results in confusion of claim scope.
  - Claim 25 is an apparatus claim which should set forth structure. It is suitable to limit the “structure” of a computer-based apparatus by defining the programmed capabilities of the computer. However, it is not clear what structure is responsible for the varying of the amounts mentioned in the claim. There is positively claimed structure (i.e. a screen) for the display of an amount, yet no structure for the determination of the variable amounts to display.
  - Claim 27, there is no antecedent basis for “the detecting step”.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (US5727153) in view of Kawan (US2002/0065712).**

4. Regarding claims 23-25, 27, 29, 4, 5, 10, 15, 16, 19, Powell teaches the concept of enabling users' cards to be swiped at product locations throughout a store to collect coupons written to the card which are redeemed at the checkout register. Powell does not describe the use of accumulating points through purchases and redeeming the points for the coupons. Kawan however, teaches the idea of frequent buyer (i.e. loyalty) points that accumulate on a customers card as a user makes purchases. A card-reading apparatus can display the user's current point balance as well as display the number of additional loyalty points needed for specific products or store credit. The terminal is capable of printing out a coupon for the selected product [¶ 38]. Given the concept that the consumer can earn mere credits or entire free products, it would have been obvious to one of ordinary skill at the time of the invention to have offered multiple coupon benefits for a product at the product shelves of Powell: a coupon for a free product if the consumer was willing to exchange a large amount of earned points, a coupon for a substantial discount (\$ or %) if the consumer was willing to exchange a fair number of earned points, or a coupon for a small discount (\$ or %). If the consumer was only willing to exchange a small amount of points. Having an option to spend more earned points for greater savings on a product would be a predictable way for one of ordinary skill to encourage the loyal purchasing habits desired. Providing display of a consumer's coupon/pricing choices relevant to his current point balance (card signal) therefore meets the claim language of displaying a varying amount depending on a signal from the purchase detection. Powell teaches a product location to include a card reader/writer at product locations adjacent to products on a shelf. Powell also describes

the use of a display at the product location “for displaying product promotional messages” as well as an LED display which confirms successful writing of a coupon. Kawan also teaches a display (fig 1, fig 9) for providing information and choices to the consumer. It would have been obvious to one of ordinary skill at the time of the invention to have displayed a confirmation and the details of a successful coupon writing, such as “your card has successfully received a \$1.00 coupon in exchange for 350 club points” so that the user has confidence in and a confirmation of a successful coupon write operation.

5. Regarding claims 2, 8, 18, Official Notice is taken that it is both well known for a company to promote its other products as well as different companies to cross-promote in order to encourage sales. It would have been obvious to one of ordinary skill at the time of the invention to have provided point-driven loyalty coupons for either the same company or a partner company.

6. Regarding claims 6, 7, 9, 17, sending a coupon to the card and the subsequent redemption of that coupon at the POS both reflect a correspondence/association with the first signal (proper points earned).

7. Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have provided a housing with the writers/readers of Powell to provide protection to the circuitry.

8. Regarding claims 26, 28, Powell teaches the presence of 5 product areas (110, 120, 130, etc. – Fig 1A).

***Response to Arguments***

9. Applicant's arguments have been considered but are moot in view of the new ground of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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Primary Examiner  
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jdc